

Notice of Allowability

Application No.

10/730,212

Examiner

Callie E. Shosho

Applicant(s)

HUBER ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 4/26/07 and telephonic interview conducted 5/2/07.
2. ☒ The allowed claim(s) is/are 1-3 and 7-16.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 5/2/07.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 13, line 2, after "is" and before "a", delete "selected from the group consisting of" and insert "derived from".

2. Authorization for this examiner's amendment was given in a telephone interview with Edward Meilman on 5/2/07.

Statement of Reasons for Allowance

3. The present claims are allowable over the "closest" prior art Hartman et al. (U.S. 5,180,802) and Paulson et al. (U.S. 6,114,430) for the following reasons:

Hartman et al. disclose compound that is a reaction product of polycarboxylic acid and monoamine. It is noted, as found for instance in present claim 12, that the compound or additive required in all the present claims is formed by reacting polyoxyalkene amine and 1,2,4-benzenetricarboxylic acid anhydride. While Hartman et al. disclose reaction product of polycarboxylic acid and monoamine wherein the polycarboxylic acid includes trimellitic anhydride, i.e. 1,2,4-benzenetricarboxylic acid anhydride, and the monoamine includes polyoxyalkylene amine, i.e. polyoxyethylene amine or polyoxypropylene amine, there is no motivation for one of ordinary skill in the art to select the combination of 1,2,4-benzenetricarboxylic acid anhydride and polyoxyalkylene amine to produce the compound or additive as presently claimed. That is, while Hartman et al. disclose reaction product obtained from polycarboxylic acid such as 1,2,4-benzenetricarboxylic acid anhydride and monoamine such as polyoxyalkylene amine, one would only arrive at such combination by choosing each of the 1,2,4-benzenetricarboxylic acid anhydride and polyoxyalkylene amine from amongst a large number of compounds. Note that a person of ordinary skill could not have attained the particular combination of 1,2,4-benzenetricarboxylic acid anhydride and polyoxyalkylene amine without either impermissible hindsight knowledge acquired directly from the instant application or by making a fortuitous selection of the combination from amongst a large number of polycarboxylic acids and monoamines disclosed by Hartman et al., especially since there is no disclosure or suggestion to select out 1,2,4-benzenetricarboxylic acid anhydride and polyoxyalkylene amine as

more favorable than the others. The latter would, of course, run contrary to the ruling of the Federal Circuit in *In re Baird* 29 USPQ2d 1550, and is thus unacceptable.

Further, even if one were to utilize reaction product of 1,2,4-benzenetricarboxylic acid anhydride and polyoxyalkylene amine in Hartman et al., there is no disclosure or suggestion in Hartman et al. that such reaction product would result in compound or additive of the structure required in all the present claims. That is, while Hartman et al. broadly disclose the use of monoamine that is polyoxyethylene amine or polyoxypropylene amine, there is no disclosure of specific polyoxyalkylene amine that would result, after reaction with 1,2,4-benzenetricarboxylic acid anhydride, in compound or additive of the structure as required in all the present claims. There is no disclosure in Hartman et al. of compound or additive of the structure as required in all the present claims.

Paulson et al. disclose reaction product of polycarboxylic acid and polyoxyalkylene diamine and disclose that the polycarboxylic acid is further reacted with polyoxyalkylene monoamine identical to that utilized in the present invention.

However, as noted above, the presently claimed compound or additive is formed from reaction product of polyoxyalkene amine and 1,2,4-benzenetricarboxylic acid anhydride. Thus, firstly it is noted that the reaction product of Paulson et al. utilizes polyoxyalkylene diamine which is not required to form the compound or additive as required in all the present claims. Further, while Paulson et al. disclose polyoxyalkylene amine identical to that presently claimed, there is no disclosure of 1,2,4-benzenetricarboxylic acid anhydride as required to form the presently claimed compound or additive. Further, given that there is no disclosure of 1,2,4-benzenetricarboxylic acid anhydride as required to form the presently claimed compound or

additive, which is also utilized in the reaction product of Hartman et al., there is no motivation to utilize the polyoxyalkylene amine of Paulson et al. in the reaction product of Hartman et al. Further, there is no disclosure in Paulson et al. of compound or additive of the structure as required in all the present claims. Additionally, while Hartman et al. is drawn to coating composition wherein the compound is utilized as a rheological additive that functions as a sag/slump control agent, Paulson et al. is drawn to aqueous composition wherein the compound is utilized to enhance the dry and wet adhesion of aqueous compositions such as paint. Thus, there is no motivation to combine Hartman et al. with Paulson et al.

Thus, it is clear that Hartman et al. or Paulson et al., either alone or in combination, do not disclose or suggest the present invention.

Further, applicants' amendment overcomes the 35 USC 112, second paragraph rejections of record.

In light of the above, the present claims are passed to issue.

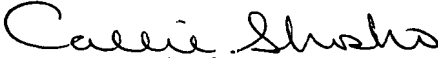
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
5/2/07